IN THE DRAWINGS

Please amend Figure 1 as follows:

Add reference 16, spring holes, as indicated in the amended drawing and delete references 21, 22, 23, and 422.

Please amend Figure 3 as follows:

Add reference 411, slide hole, as indicated in the amended drawing and delete references 21, 22, 23, and 422.

Please amend Figure 4 as follows:

Add reference 411, slide hole, as indicated in the amended drawing and delete references 21, 22, 23, and 422.

Remarks

The Office Action mailed July 27, 2005 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-13 are now pending in this application. Claims 1-6 and 8-13 stand rejected. Claim 7 is objected to.

The objection to the drawings is respectfully traversed. Figure 1 has been amended to include reference 16 and delete references 21, 22, 23, and 422. Figures 3 and 4 have been amended to include reference 411 and delete references 21, 22, 23, and 422. No new matter has been added. Accordingly, Applicant requests that the objection to the drawings be withdrawn.

The objection to Claim 7 is respectfully traversed. Applicant submits that independent Claim 1 and dependant Claim 6, from which Claim 7 depends, are now in condition for allowance. Accordingly, Applicant requests that the objection to Claim 7 be withdrawn.

The rejection of Claims 5 and 8 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement is respectfully traversed. Claims 5 and 8 have been amended. Applicant, submits that Claims 5 and 8 are now in compliance with the enablement requirement of Section 112, first paragraph, and are now in condition for allowance. Accordingly, Applicant requests that the rejection of Claims 5 and 8 be withdrawn.

The rejection of Claims 1-3, 6, and 11-13 under 35 U.S.C. § 102(b) as being anticipated by Sprague (U.S. Patent No. 4,087,102) is respectfully traversed.

Sprague describes a luggage container including parallel arms (27 and 28) connected to a handle (29) and an anchorage cross-bar (32). As handle (29) is retracted into the luggage container, anchorage cross-bar (32) slides along longitudinal slide tracks (40 and 42).

Longitudinal slide tracks (40 and 42) are uniformly twisted about their length in a helical pattern. As anchorage cross-bar (32) slides along longitudinal slide tracks (40 and 42), longitudinal slide tracks (40 and 42) rotate and slidably push a yoke control member (68). As yoke control member (68) slides, it rotates wheels (60 and 62) outward from the luggage container. Notably, Sprague does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container.

Claim 1 recites a container wheel control mechanism, comprising "a container handle, mechanically coupled to a container, configured to expand and compress . . . a container wheel mechanically coupled to the container handle and responsive to movement of the container handle, configured to extend linearly downward from the surface of the container when the container handle is expanded and to retract from the surface of the container when the container handle is compressed."

Sprague does not describe nor suggest a retractable luggage wheel, as recited in Claim 1. Specifically, Sprague does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container. Rather, in contrast to the present invention, Sprague describes a luggage container having wheels that rotate outward from the luggage container. Accordingly, Claim 1 is submitted to be patentable over Sprague.

Claims 2-3 and 6 depend from independent Claim 1. When the recitations of Claims 2-3 and 6 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-3 and 6 likewise are patentable over Sprague.

Claim 11 recites a method for controlling a container wheel, comprising "retracting the container wheel in response to compression of a container handle; and extending the container wheel linearly downward in response to expansion of the container handle."

Sprague does not describe nor suggest a method for controlling a container wheel, as recited in Claim 11. Specifically, Sprague does not describe nor suggest extending a wheel linearly downward from a luggage container. Rather, in contrast to the present invention,

Sprague describes a luggage container having wheels that rotate outward from the luggage container. Accordingly, Claim 11 is submitted to be patentable over Sprague.

Claims 12 and 13 depend from independent Claim 11. When the recitations of Claims 12 and 13 are considered in combination with the recitations of Claim 11, Applicant submits that dependent Claims 12 and 13 likewise are patentable over Sprague.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102 rejection of Claims 1-3, 6, and 11-13 be withdrawn.

The rejection of Claims 1-6, 9, and 11-13 under 35 U.S.C. § 102(a) as being anticipated by Chang (U.S. Patent No. 6,360,400) is respectfully traversed.

Chang describes a luggage barrow including a telescopic handle assembly (70). The luggage barrow further includes a wheel bracket (30) attached via pivot holes (240). Wheel bracket (30) includes bent slot (34) including an upper bent portion (340) and a lower bent portion (342) Wheel bracket (30) further includes a wheel (38) pivotally connected with the lower end of wheel bracket (30) and configured to be retained within a wheel recess (62). When handle assembly (70) is pulled up, the lower end of lower inner tube (764) is separated from a connecting bar (56) causing a passing member (50) and linkage (40) to move upward by a pressing force of a spring (48). Pin (462) connected with the linkage (40) is then moved upwards along straight slot (242)and bent slot (34) from the bottom of lower bent portion (342) to the top of upper bent portion (340) causing wheel bracket (30) to pivotally turn outward and wheel (38) to extend out of wheel recess (62). Notably, Chang does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container.

Claim 1 recites a container wheel control mechanism, comprising "a container handle, mechanically coupled to a container, configured to expand and compress . . . a container wheel mechanically coupled to the container handle and responsive to movement of the container handle, configured to extend linearly downward from the surface of the container

when the container handle is expanded and to retract from the surface of the container when the container handle is compressed."

Chang does not describe nor suggest a retractable luggage wheel, as recited in Claim 1. Specifically, Chang does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container. Rather, in contrast to the present invention, Chang describes a luggage barrow including a wheel that extends outward while being pivoted. Accordingly, Claim 1 is submitted to be patentable over Chang.

Claims 2-6 and 9 depend from independent Claim 1. When the recitations of Claims 2-6 and 9 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-6 and 9 likewise are patentable over Chang.

Claim 11 recites a method for controlling a container wheel, comprising "retracting the container wheel in response to compression of a container handle; and extending the container wheel linearly downward in response to expansion of the container handle."

Chang does not describe nor suggest a method for controlling a container wheel, as recited in Claim 11. Specifically, Chang does not describe nor suggest extending a wheel linearly downward from a luggage container. Rather, in contrast to the present invention, Chang describes a luggage barrow including a wheel that extends outward while being pivoted. Accordingly, Claim 11 is submitted to be patentable over Chang.

Claims 12 and 13 depend from independent Claim 11. When the recitations of Claims 12 and 13 are considered in combination with the recitations of Claim 11, Applicant submits that dependent Claims 12 and 13 likewise are patentable over Chang.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102 rejection of Claims 1-6, 9, and 11-13 be withdrawn.

The rejection of Claims 1-3, 6, and 11-13 under 35 U.S.C. § 102(a) as being anticipated by Cassimally (U.S. Patent No. 4,273,222) is respectfully traversed.

Cassimally describes a luggage trolley including a foldable framework (12). Foldable framework (12) includes a rigid frame (26) and support arms (36) pivotally connected to rigid frame (26). The luggage trolley further includes a wheel assembly (46) including a wheel support (62) pivotally mounted within a recess (50) by a pin (68). Wheel support (62) includes a wheel (60) rotatably mounted therein. As foldable framework (12) is released from the luggage trolley, support arms (36) are swung upwardly and arm end portion (58) travels downwardly to make contact with a wheel support wall (70). Wheel support wall (70) urges wheel assembly (46) out of recess (50) with wheel (60) moving outwardly and downwardly through recess (50). Notably, Cassimally does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container.

Claim 1 recites a container wheel control mechanism, comprising "a container handle, mechanically coupled to a container, configured to expand and compress . . . a container wheel mechanically coupled to the container handle and responsive to movement of the container handle, configured to extend linearly downward from the surface of the container when the container handle is expanded and to retract from the surface of the container when the container handle is compressed."

Cassimally does not describe nor suggest a retractable luggage wheel as recited in Claim 1. Specifically, Cassimally does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container. Rather, in contrast to the present invention, Cassimally describes a luggage trolley including a wheel that pivots outward from within the luggage trolley. Accordingly, Claim 1 is submitted to be patentable over Cassimally.

Claims 2-3 and 6 depend from independent Claim 1. When the recitations of Claims 2-3 and 6 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-3 and 6 likewise are patentable over Cassimally.

Claim 11 recites a method for controlling a container wheel, comprising "retracting the container wheel in response to compression of a container handle; and extending the container wheel linearly downward in response to expansion of the container handle."

Cassimally does not describe nor suggest a method for controlling a container wheel, as recited in Claim 11. Specifically, Cassimally does not describe nor suggest extending a wheel linearly downward from a luggage container. Rather, in contrast to the present invention, Cassimally describes a luggage trolley including a wheel that pivots outward from within the luggage trolley. Accordingly, Claim 11 is submitted to be patentable over Cassimally.

Claims 12 and 13 depend from independent Claim 11. When the recitations of Claims 12 and 13 are considered in combination with the recitations of Claim 11, Applicant submits that dependent Claims 12 and 13 likewise are patentable over Cassimally.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102 rejection of Claims 1-3, 6, and 11-13 be withdrawn.

The rejection of Claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Cassimally (U.S. Patent No. 4,273,222) in view of Boville (U.S. Patent No. 5,228,706) is respectfully traversed.

Cassimally is described above. Boville describes a cooler including a wheel positioning means. The wheel positioning means includes a strut (23) and a strut-positioned wheel assembly (25). Wheel assembly (25) includes an elongate lever (27) mounted for pivoting movement near a pivot point (29). Wheel assembly (25) also includes a wheel (31) mounted on an axel (33) at the end of lever (27). The top end of strut (23) is rounded and connected by a cam-like surface (47). When handle (41) is drawn outward such that handle surface (47) no longer interferes with strut (23), strut (23) is urged upward by a spring (39). As a result, lever (27) pivots at pivot point (29) causing wheel (31) to extend outward from the cooler. Notably Boville does not describe nor suggest a container wheel configured to extend linearly downward from the surface of the container.

Applicant respectfully submits that obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Cassimally with Boville, or vice versa. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicants." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

> [i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, "it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present

invention. Of course, such a combination is impermissible, and for at least this reason, Applicant submits that Claims 9 and 10 are patentable over Cassimally in view of Boville.

Claims 9 and 10 depend from independent Claim 1. To the extent understood, no combination of Cassimally and Boville describes or suggests a container wheel configured to extend linearly downward from the surface of the container, as recited in Claim 1. Specifically, Claim 1 recites a container wheel control mechanism, comprising "a container handle, mechanically coupled to a container, configured to expand and compress . . . a container wheel mechanically coupled to the container handle and responsive to movement of the container handle, configured to extend linearly downward from the surface of the container when the container handle is expanded and to retract from the surface of the container when the container handle is compressed."

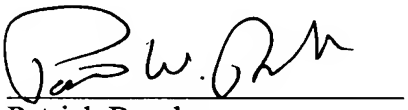
Neither Cassimally nor Boville, considered alone or in combination, describe or suggest the retractable luggage wheel of Claim 1. Specifically no combination of Cassimally or Boville describes or suggests a container wheel configured to extend linearly downward from the surface of the container. Rather, in contrast to the present invention Cassimally describes a luggage trolley including a wheel that pivots outward from within the luggage trolley, and Boville describes a wheel attached to a lever and fulcrum such that the wheel pivots outwardly from a cooler. As such, no combination of Cassimally and Boville describes or suggests the present invention. Accordingly, Applicant submits that Claim 1 is patentable over Cassimally in view of Boville.

Claims 9 and 10 depend, directly or indirectly, from Claim 1. When the recitations of Claims 9 and 10 are considered in combination with the recitations of Claim 1, Applicant submits that Claims 9 and 10 likewise are patentable over Cassimally in view of Boville.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 9 and 10 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully requested.

Respectfully Submitted,



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